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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,845	10/17/2003	Antonella Pesce	CM2526C	9579
27752 7590 01/09/2008 THE PROCTER & GAMBLE COMPANY INTELLECTUAL PROPERTY DIVISION - WEST BLDG. WINTON HILL BUSINESS CENTER - BOX 412 6250 CENTER HILL AVENUE CINCINNATI, OH 45224			EXAMINER ARNOLD, ERNST V	
			ART UNIT 1616	PAPER NUMBER
			MAIL DATE 01/09/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/687,845

Applicant(s)

PESCE ET AL.

Examiner

Ernst V. Arnold

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-17, 19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-17, 19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 1-9 and 18 have been cancelled. Claims 10-17, 19 and 20 are pending and under examination. Upon further search and consideration, the Examiner has a new ground of rejection. Accordingly, this action is non-final.

Withdrawn rejections:

Claims 10-17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Williams (US 6,506,958) in view of Hasegawa et al. (US 5,364,626). Applicants arguments were persuasive and the Examiner withdraws the rejection.

Claims 10-17, 19 and 20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Brunner et al. (US 5,733,272) in view of Furman (US 5,451,404). Applicants arguments were persuasive and the Examiner withdraws the rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 10-17, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams (US 6,506,958) in view of Schneider et al. (US 4,583,980) and Furman (US 5,451,404).

Applicant claims a hygienic article comprising a composition comprising a cooling agent with an ester derivative.

Determination of the scope and content of the prior art

(MPEP 2141.01)

Williams teaches a signal tampon with an indicator designed to provide a sensory signal to the user (Abstract). The sensory signal can be a cold sensation produced by a cold sensation material such as menthyl lactate (a cyclohexyl structure), menthol, ethanol or combinations thereof (Column 4, lines 1-10 and claim 16). It is the Examiner's position that the teaching of Williams suggests combining a first cooling agent, menthol, with a second cooling agent such as menthyl lactate.

Schneider teaches a sanitary hygiene product having odor preventing properties that contains triethyl citrate (claims 1-4; column 3, lines 29-49 and column 4, lines 1-15). Schneider teaches that the triethyl citrate can be mixed with perfume oils (column 3, lines 35-49). Schneider teaches that triethyl citrate has the strongest odor preventing effect and best suitability for practical application (column 3, lines 2-5).

Furman teaches cooling compositions comprising a ketal and a secondary coolant, which may be menthol, carboxamides or mixtures thereof (Abstract; column 2, line 28 through column 5, line 53 and claims 1-10). The compositions can be applied to the body (column 5, line 57 and include toilet articles (column 6, lines 11-12 and claim 8). The composition can be formulated into a carrier such as solids, liquids, emulsions, foams and gels (column 6, lines 19-32).

Ascertainment of the difference between the prior art and the claims

(MPEP 2141.02)

1. The difference between the instant application and that of Williams is that Williams do not expressly teach the signal tampon with an ester derivative or other cooling agents such as ketals and carboxamides. This deficiency in Williams is cured by the teachings of Schnieder and Furman.

2. The difference between the instant application and that of Williams is that Williams do not expressly teach the signal tampon with a first cooling agent and a second cooling agent in a weight ratio of 1/1 to 1/100.

3. The difference between the instant application and that of Williams is that Williams do not expressly teach the signal tampon wherein the cooling agent or a mixture thereof is present at a level of about 0.1% to about 99.9% and wherein the ester derivative or a mixture thereof is present at a level of from 99.9% to 0.1% by weight of the total composition.

4. The difference between the instant application and that of Williams is that Williams do not expressly teach the article wherein the composition is suitable for topical application to the external surface of a mammal in the form of a cream, lotion, emulsion, dispersion, gel, foam, oil, ointment or powder.

Finding of prima facie obviousness

Rational and Motivation (MPEP 2142-2143)

1. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to add an ester of citric acid, such as triethyl citrate, as suggested by Schnieder, or other cooling agents as suggested by Furman, to the hygienic article, tampon, of Williams and produce the instant invention.

One of ordinary skill in the art would have been motivated to do this because Schneider teaches that triethyl citrate is the best suitable odor preventing agent for this application. In addition: "It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art." In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980). Furthermore, Furman establishes a wide variety of other cooling agents which could be utilized in the tampon of Williams.

2. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to add a first cooling agent and a second cooling agent in a weight ratio of 1/1 to 1/100 to the composition of Williams and produce the instant invention.

One of ordinary skill in the art would have been motivated to do this because Williams suggests combining cooling agents and it is merely routine optimization for one of ordinary skill in the art to arrive at the ratio of 1/1 to 1/100 by weight of the cooling agents.

3. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to add the cooling agent or a mixture thereof at a level of about 0.1% to about 99.9% and wherein the ester derivative or a mixture thereof is at a level of from 99.9% to 0.1% by weight of the total composition in the composition of Williams and produce the instant invention.

One of ordinary skill in the art would have been motivated to do this because Williams and Schneider provide the ingredients and it is merely routine optimization by one of ordinary skill in the art to arrive at the instantly claimed amounts. In fact Schneider provides guidance on how to apply the triethyl citrate in column 3, lines 12-34).

4. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to make the article of Williams wherein the composition is suitable for topical application to the external surface of a mammal in the form of a cream, lotion, emulsion, dispersion, gel, foam, oil, ointment or powder.

One of ordinary skill in the art would have been motivated to do this because Williams teaches that the indicator can be in a hydrogel, which is a type of gel (Column 3, lines 51-52).

Summary: The art teaches the use of triethyl citrate and cooling agents in sanitary hygienic articles. It is merely ordinary innovation to combine triethyl citrate and a cooling agent into a hygienic article. The expected result remains a signal tampon. From recent case law: "The

combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” And; “The results of ordinary innovation are not the subject of exclusive rights under the patent laws.” KSR INTERNATIONAL CO. v. TELEFLEX INC. ET AL. pgs. 12, 24; 550 U. S. ____ (2007)"

In the absence of any criticality/unexpected results, the presently claimed invention is considered *prima facie* obvious over the prior art for the reasons of record and those stated above. It is applicant's burden to demonstrate unexpected results over the closest prior art. See MPEP 716.02, also 716.02 (a) - (g). Furthermore, the unexpected results should be demonstrated with evidence that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance. *Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992). Moreover, evidence as to any unexpected benefits must be "clear and convincing" *In re Lohr*, 137 USPQ 548 (CCPA 1963), and be of a scope reasonably commensurate with the scope of the subject matter claimed, *In re Linder*, 173 USPQ 356 (CCPA 1972).

A reference is good not only for what it teaches by direct anticipation but also for what one of ordinary skill in the art might reasonably infer from the teachings. (*In re Opprecht* 12 USPQ 2d 1235, 1236 (Fed Cir. 1989); *In re Bode* 193 USPQ 12 (CCPA) 1976).

In light of the forgoing discussion, the Examiner concludes that the subject matter defined by the instant claims would have been obvious within the meaning of 35 USC 103(a).

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention.

Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at

the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

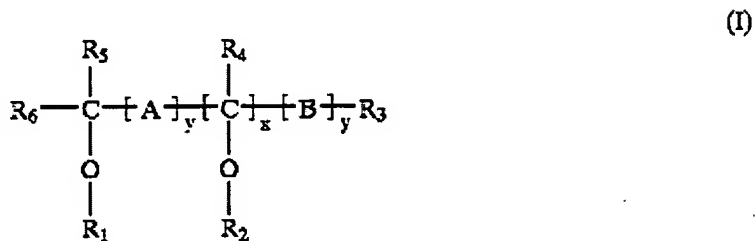
A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

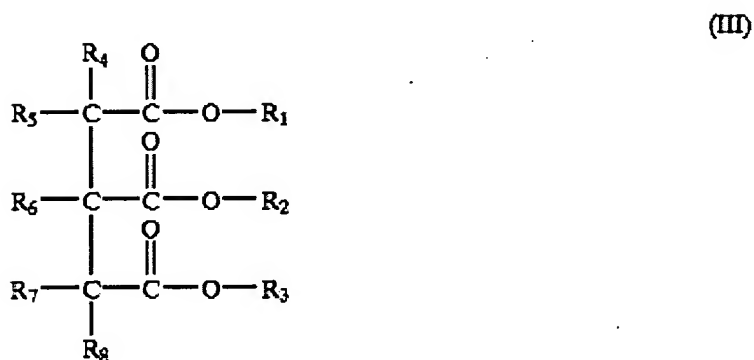
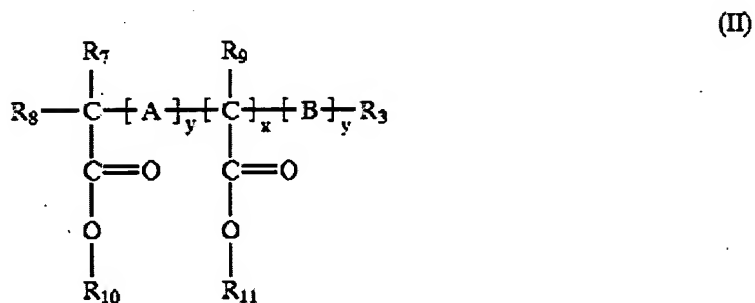
Claims 10-15 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,972,010. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter of the instant application is embraced by the claimed subject matter in the patent.

Claim 1 of US 6,972,010 is drawn to an absorbent article comprising an agent able to convey a perception to the wearer and a delivery system for containing and delivering the agent

to the skin. Claim 1 of US 6,972,010 also recites wherein the delivery system comprises an alcohol or ester derivative of the following formulae:



or



Thus, the instant ester derivatives are fairly taught in US 6,972,010. The article and agent are not described in the claim language. The Examiner notes that: MPEP § 804 (II) states, "When

considering whether the invention defined in a claim of an application would have been an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art. *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 1279, 23 USPQ2d 1839, 1846 (Fed. Cir. 1992). This does not mean that one is precluded from all use of the patent disclosure.” (*emphasis added*). “Further, those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in the application defines an obvious variation of an invention claimed in the patent. *In re Vogel*, 422 F.2d 438, 441-42, 164 USPQ 619, 622 (CCPA 1970).”

Therefore, the Examiner looked to the specification for guidance on the type of agent and type of article. The article is described as being panty liners, for example, with topsheets and backsheets fully discussed (Column 25, line 1 through column 33, line 57). The agent is disclosed as being derivatives of ketals, carboxamides, cyclohexanol, cyclohexyl as well as a number of oils such as peppermint oil that can convey a perception, freshness sensation, to the wearer (Column 7, line 13 and 46 through column 14, line 60). One of ordinary skill in the art would have recognized the obvious variation of the instant invention over US 6,972,010 due to the overlap in claimed subject matter as described above.

II. Claims 10-17 and 19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2-6 and 8-13 of copending Application No. 11/106,402. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter is embraced by the subject matter of the copending application. The copending application claims an absorbent article, such as a

panty liner, comprising an agent able to convey a perception to the wearer wherein the agent is a cooling agent selected from the group consisting of ketals, carboxamides, cyclohexyl derivatives, etc....(Claims 2-5). The article comprises a delivery system which is an emollient containing composition comprises from about 0.1% to about 99.9% by weight of the agent and from about 99.1% to about 0.1% by weight of the emollient and the delivery system comprises triethyl citrate (claims 8-11). The article comprises a topsheet (claims 12-13). The article comprises menthol as a first cooling agent in combination with a second cooling agent (Claim 6). One of ordinary skill in the art would have recognized the obvious variation of the instant invention over the copending claims due to the overlap in subject matter as described above.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to arguments:

Applicant has agreed (see remarks of 5/21/07) to submit terminal disclaimers upon indication of allowable subject matter. Until such a time the claims remain rejected.

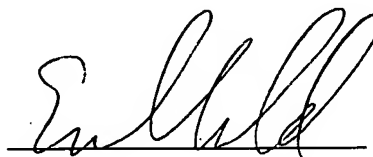
Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernst V. Arnold whose telephone number is 571-272-8509. The examiner can normally be reached on M-F (6:15 am-3:45 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Ernst Arnold', is written over a horizontal line.

Ernst Arnold
Patent Examiner
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Art Unit 1616